



IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Application of

Thrift, et al.

Serial No.: 08/419,229

Filed: 4/10/95

For: VOICE ACTIVATED HYPERMEDIA SYSTEMS USING GRAMMATICAL  
METADATA

TI-20205

Examiner: Chawan

Art Unit: 2308

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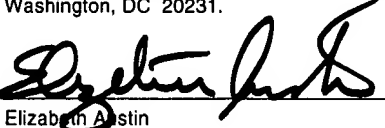
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REQUEST FOR RECONSIDERATION TRANSMITTAL FORM Technology Center 2600

Assistant Commissioner for Patents

Washington, DC 20231

Dear Sir:

MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8 (A)	
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 Elizabeth Austin	3/15/2001 Date

Transmitted herewith in triplicate is a Request for Reconsideration of the Board of Appeals Decision in the above-identified application.

Charge any additional fees, or credit overpayment to the deposit account of Texas Instruments Incorporated, Account No. 20-0668. An original and two copies of this sheet are enclosed.

Respectfully submitted,



Ronald O. Neerings  
Attorney for Applicants  
Registration No. 34,227

Texas Instruments Incorporated  
P. O. Box 655474, M.S. 3999  
Dallas, Texas 75265  
(972) 917-5299





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**REQUEST PURSUANT TO 37 CFR 1.197(b) FOR RECONSIDERATION OF  
BOARD OF APPEALS DECISION**

Assistant Commissioner of Patents

Washington, D.C. 20231

**MAILING CERTIFICATE UNDER 37 C.F.R. § 1.8(a)**

I hereby certify, that on this date, this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231.

*Elizabeth Austin*  
Elizabeth Austin

3/15/2001  
Date

Dear Sir:

This paper is filed (in triplicate) in response to the Board of Appeals Decision mailed on February 28, 2001. Please charge any fees required by this paper to the deposit account of Texas Instruments Incorporated, Deposit Account No. 20-0668.

**INTRODUCTION**

Appellants hereby respectfully request reconsideration of the aforementioned decision of the Board of Appeals for the following reasons:

- 1) The Board erred in determining that the "Examiner's analysis is sufficiently reasonable that we (the Board) find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness" (Decision, page 5, lines 17-16), as applied to Claim 1 and through claim dependency, Claims 2-4;

- 2) The Board erred in determining that the "Examiner's reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the Examiner's position", (Decision, page 9, lines 4-19), regarding Claims 5-19.
- 3) The Board erred in affirming the wrong rejection.

### ARGUMENT

1) The Board states in its Decision regarding Claim 1, "In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of obviousness" (Decision, page 5, lines 13-16). Appellants respectfully request reconsideration of this determination.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references", In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). The Examiner in the present case has not met this burden.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest ALL the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Neither the Schmandt nor Stefanopoulos reference suggest, or provide any motivation for, a combination of the reference teachings (and the Examiner makes no such allegation). Accordingly, the suggestion or motivation must come from "the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings". The Examiner's rationale for obviousness is as follows:

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to use the method of using speech to navigate in a windows environment as taught by Schmandt et al., and incorporating it into the hypermedia structured knowledge base system as taught by Stefanopoulos et al., to obtain a speech interface **to the Web that allows easy access to information on the Web by reducing manual, intervention [i.e., the use of keyboard], and which is user friendly** (Paper #4 (Office Action dated August 7, 1996), page 3, lines 12-17).

First, neither Schmandt nor Stefanopoulos teach or suggest, "accessing the Web". Second, while Schmandt discloses a speech interface for an X Windows System, Schmandt DOES NOT teach or suggest that it's speech agent **will reduce "the use of a keyboard"** or that it is **"user friendly"**, as determined by the Examiner (and affirmed by the Board).

Schmandt specifically discloses:

Speech **DOES NOT provide a keyboard substitute**, but it does assume some of the functions currently assigned to the mouse. Thus, a user can manage a number of windows **without removing his or her hands from the keyboard** (page 50, column 1, lines 12-18).

Accordingly, the Board committed error in confirming the Examiner's determination that Schmandt's speech interface will "reduce the use of a keyboard".

Further, to set the record straight, Appellants respectfully point out that the Examiner NEVER equated a mouse (or mouse clicks) as being the same as a keyboard (or keyboard inputs) (see, Office Action dated August 7, 1996, and Answer dated 11/13/97) as suggested by the Board in its Decision (page 5, lines 4-6).

Furthermore, there is no teaching or suggestion in Schmandt that would lead one of ordinary skill in the art at the time of the invention to make the determination that Schmandt's speech interface is "user friendly". Schmandt specifically discloses:

Speech proved to be **neither faster nor slower than the mouse**, although the choice of which medium to employ was in part related to what else the user was doing with his or her hands (page 50, column 2, lines 3-7);

From our analysis of these empirical and observational data, we reached the following conclusion about our users' experiences with Xspeak:

A) **Recognition is not straightforward** (page 53, column 1, last line - column 2, line 4) including the problem that despite actions by Schmandt and his co-authors, **low recognition accuracy rates remained a problem** (page 53, column 2, lines 21-22) and **"poor recognition accuracy was the greatest impediment** to acceptance of Xspeak (page 53, column 2, lines 27-29);

B) Some programmers preferred using a faster workstation without Xspeak to using a slower workstation with the speech interface (page 53, column 2, line 30-column 3, line 2);

C) For simple change-of-focus tasks (moving the mouse from one exposed window to another exposed window), **speech was not faster than the mouse**. In fact, it was marginally slower (page 53, column 3, lines 8-12);

D) Some users were **not helped much by the voice interface** (page 53, column 3, lines 26-27);

E) We (Schmandt et al.,) found the use of voice in navigation **an incomplete substitute for the mouse**. Our users **did not rely on the speech interface to the exclusion of the mouse**. They **still had to use the pointer to interact with the direct-manipulation interfaces** within applications (page 54, lines 6-12).

Accordingly, one of ordinary skill in the art would NOT (indeed could not) have assumed that a speech interface would be a more user friendly input than a keyboard.

Appellants respectfully submit that Board committed error in determining that the Examiner met the first step (there must be some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings) in the three-step process for meeting the basic requirements of presenting a prima facie case of obviousness.

Even had the Examiner presented sufficient evidence to meet the above first step in the three-step process for meeting the basic requirements of presenting a prima facie case of obviousness, the Board committed error in finding that the Examiner met the second step of the test for determining obviousness - that there must be a reasonable expectation of success. From the above-discussed conclusions of Schmandt et al., one of ordinary skill in the art can only determine that there can be NO reasonable expectation of success of combining Schmandt's speech interface with Stefanopolous's apparatus (to reduce to the use of a keyboard, and to use a speech interface that is more user friendly than a keyboard), in order to arrive at the invention of Appellants' Claim 1.

Finally, the Board committed error in determining that the Examiner met the third step of the test for determining obviousness - the prior art reference (or references when combined - Schmandt and Stefanopolous) must teach or suggest ALL the claim limitations. The Examiner admits (Office Action dated March 27, 1997 - the Final Rejection) that "Stefanopoulos et al., in view of Schmandt et al., teach the limitations as described in paper #4, paragraph #3, **EXCEPT for the newly added limitation of "...an information resource located on a computer network..."**". Accordingly, a combination of the Schmandt and Stefanopoulos references DOES NOT teach all of the limitations of Claim 1.

Case law holds that all of the three steps must be present in the three-step process for meeting the basic requirements of presenting a prima facie case of obviousness. Appellants have shown that none of the above three steps was met by the Examiner. Accordingly, the Board committed error in determining that the Examiner had "at least satisfied the burden of presenting a prima facie case of obviousness" of Claim 1. Appellants respectfully request the Board to reverse itself and determine that the Examiner has NOT satisfied the burden of presenting a prima facie case of obviousness" of Claim 1, and through claim dependency, Claims 2-10.

2) The Board held that, in its view, the Examiner's reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the Examiner's position regarding Claims 5-19 (Decision, page 9, lines 16-19). The Boards' rationale is as follows:

We note initially that independent Claims 11 and 14 are similar to independent Claim 1, discussed supra, **but adds limitations directed to the construction and extraction of grammar related features as part of the speech user agent.** Dependent claims 5-10, 12, 13, and 15-19 primarily delineate **further speech recognition grammar construction and extraction features.**

The Examiner at pages 6-8 of the Answer, and at pages 3-7 of the Office action mailed August 7, 1996, paper no. 4, referenced in the Examiner's statement of the grounds of rejection, addresses the language of these claims and **provides a line of reasoning for asserting the obviousness or inherent nature of each of the claimed features.** In our view, the Examiner's reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the Examiner's position (Decision, page 9, lines 4-19).

Appellants respectfully request reconsideration of the above-determination of the Board. To the extent Claims 11 and 14 are similar to independent Claim 1, Appellants reassert their arguments (as set forth above in #1 in support of reversing the Boards' determination that the Examiner provided a prima facie case of the obviousness of Claims 1-4), in support of reversing the Boards' determination that the Examiner provided a prima facie case of the obviousness of Claims 5-19.

Further, the Board noted that Claims 11 and 14 are similar to independent Claim 1 discussed supra, but add limitation directed to the construction and extraction of grammar related features as part of the speech user agent. Dependent Claims 5-10, 12, 13, and 15-19 primarily delineate further speech recognition grammar construction and extraction features (Decision, page 9, lines 4-10).

Appellants list below independent Claims 11 and 14 to distinctly identify those "additional limitations directed to the construction and extraction of grammar related features as part of the speech user agent".

Independent Claim 11 requires and positively recites, a voice activated Hypermedia system using grammatical metadata, said system comprising: "a speech user agent", "a network browsing module", "an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource", **"a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source"**, **"a means for modifying said grammar"**, **"a means for automatically producing an intelligent grammar from said information resource"** and **"a means for processing said grammar to produce a reference to said hypermedia"**.

Independent Claim 14 requires and positively recites, A voice activated Hypermedia system using grammatical metadata, said system comprising: "a speech user agent", "a browsing module", "an information resource" and **"a means for producing a grammar from textual representation of links to said information resource"**.

Regarding the highlighted portions of Claim 11, the Examiner states only, "the use of grammar is old and well known in the art of speech recognition as a means of optimization which is high desirable". The Examiner's fails to address the claimed language and his resulting argument makes NO SENSE in light of the elements of Claims 11 and 14.

Where is the Examiner's argument, or evidence for proving, that **"a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source"**, as required by Claim 11, is old and well know in the art and would be obvious to apply to the present invention? It surely is not found at pages 6-8 of the Answer and at pages 3-7 of the Office action mailed August 7, 1996, as suggested by the Board. Moreover, the Examiner's rejection of Claim 11 does not comply with the requirements of MPEP 706.02(j). MPEP 706.02(j) sets forth the contents of a 35 U.S.C. 103 rejection.

35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably



with the reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner's failure to address the above element confirms that the Examiner failed to address all of above-cited elements #1-#4 of MPEP 706.02(j).

The Board and Examiner's determination of obviousness regarding this claim element is supposition not supported by fact, and is therefore erroneous. Accordingly, this is one reason the Board erred in determining that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11. Appellants request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11 and reverse its affirmance of the obviousness of Claim 11.

Where is the Examiner's argument, or evidence for proving, that “a means **for modifying said grammar**”, as required by Claim 11, is old and well know in the art and would be obvious to apply to the present invention? It surely is not found at pages 6-8 of the Answer and at pages 3-7 of the Office action mailed August 7, 1996. Moreover, the Examiner's rejection of Claim 11 does not comply with the requirements of MPEP 706.02(j). MPEP 706.02(j) sets forth the contents of a 35 U.S.C. 103 rejection.

35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with the reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner's failure to address the above element confirms that the Examiner failed to address all of above-cited elements #1-#4 of MPEP 706.02(j).

The Board and Examiner's determination of obviousness regarding this claim element is supposition not supported by fact, and is therefore erroneous. Accordingly, this is a second reason the Board erred in determining that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11. Appellants request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11 and reverse its affirmance of the obviousness of Claim 11.

Where is the Examiner's argument, or evidence for proving, that “a means **for automatically producing an intelligent grammar from said information resource**”, as required by Claim 11, is old and well know in the art and would be obvious to apply to the present invention? It surely is not found at pages 6-8 of the Answer and at pages 3-7 of the Office action mailed August 7, 1996, as suggested by the Board. Moreover, the Examiner's rejection of Claim 11 does not comply with the requirements of MPEP 706.02(j). MPEP 706.02(j) sets forth the contents of a 35 U.S.C. 103 rejection.

35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with the reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner's failure to address the above element confirms that the Examiner failed to address all of above-cited elements #1-#4 of MPEP 706.02(j).

The Board and Examiner's determination of obviousness regarding this claim element is supposition not supported by fact, and is therefore erroneous. Accordingly, this is a third reason

the Board erred in determining that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11. Appellants request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11 and reverse its affirmance of the obviousness of Claim 11.

Where is the Examiner's argument, or evidence for proving, that "a means for **processing said grammar to produce a reference to said hypermedia**", as required by Claim 11, is old and well known in the art and would be obvious to apply to the present invention? It surely is not found at pages 6-8 of the Answer and at pages 3-7 of the Office action mailed August 7, 1996. Moreover, the Examiner's rejection of Claim 11 does not comply with the requirements of MPEP 706.02(j). MPEP 706.02(j) sets forth the contents of a 35 U.S.C. 103 rejection.

35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with the reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner's failure to address the above element confirms that the Examiner failed to address all of above-cited elements #1-#4 of MPEP 706.02(j).

The Board and Examiner's determination of obviousness regarding this claim element is supposition not supported by fact, and is therefore erroneous. Accordingly, this is a fourth reason the Board erred in determining that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11. Appellants request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 11 and reverse its affirmance of the obviousness of Claim 11.

Where is the Examiner's argument, or evidence for proving, that **"a means for producing a grammar from textual representation of links to said information resource"**, as required by Claim 14, is old and well know in the art and would be obvious to apply to the present invention? It surely is not found at pages 6-8 of the Answer and at pages 3-7 of the Office action mailed August 7, 1996. Moreover, the Examiner's rejection of Claim 14 does not comply with the requirements of MPEP 706.02(j). MPEP 706.02(j) sets forth the contents of a 35 U.S.C. 103 rejection.

35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with the reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

The Examiner's failure to address the above element confirms that the Examiner failed to address all of above-cited elements #1-#4 of MPEP 706.02(j).

The Board and Examiner's determination of obviousness regarding this claim element is supposition not supported by fact, and is therefore erroneous. Appellants respectfully request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claim 14 and reverse its affirmance of the obviousness of Claim 14.

Regarding Claims 12, 13, and 15-19, the Board specifically states (regarding Claims 5-19), "We do not dispute Appellants' contention that the applied references do not explicitly disclose several of the various features of claims 5-19; however, Appellants' minimal arguments do not address the Examiner's position of obviousness or inherency with respect to the features cited in these claims" (Decision, page 10, lines 3-8). Appellants have clearly shown that the Board erred in determining that the Examiner satisfied his burden of presenting a prima facie case of the

obviousness of Claims 11 and 14. Being that Claims 12, 13 and 15-19 depend, directly or indirectly, from Claims 11 and 14, Appellants request that the Board reverse its determination that the Examiner satisfied his burden of presenting a prima facie case of the obviousness of Claims 12, 13 and 5-19 and reverse its affirmance of the obviousness of Claims 12, 13 and 5-19.

Appellants point out that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined ONLY if there is some suggestion or incentive to do so.**" ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner and the Board does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127.

Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985). Moreover, the CAFC has stated that "One cannot use hindsight reconstruction to pick and choose among isolated disclosure in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1600.

3) Appellants respectfully submit that the Board committed error in affirming the wrong 35 U.S.C. 103 rejection. In the Office Action dated August 7, 1996, the Examiner rejected Claims 1-19 under 35 U.S.C. 103 as being unpatentable over Stefanopoulos et al.,[5,333,237] and in view of Schmandt et al.,["Augmenting a Window System with Speech Input", Computer Magazine, 8/90, Vol. 23, Issue 8, pages 50-56] (Office Action dated August 7, 1996, page 3, lines 1-4). In a subsequent Office Action dated March 27, 1997 (the Final Rejection), the Examiner

again rejected Claims 1-19 under 35 U.S.C. 103 as being unpatentable over Stefanopoulos et al.,[5,333,237] and in view of Schmandt et al.,["Augmenting a Window System with Speech Input", Computer Magazine, 8/90, Vol. 23, Issue 8, pages 50-56] (Office Action dated March 27, 1997, page 2, lines 7-10), **but thereafter states**, "As per claims 1-19, Stefanopoulos et al, in view of Schmandt et al., teach the limitations as described in paper #4, paragraph #3, **except for the newly added limitation of "... an information resource located on a computer network..."** (Office Action dated March 27, 1997, page 2, lines 11-13).

The Examiner's above statement suggests that the rejection was changed in the Office Action dated March 27, 1997. Instead of a rejection of Claims 1-19 under 35 U.S.C. 103 as being unpatentable over Stefanopoulos et al., and in view of Schmandt et al., the rejection in reality is something else. Perhaps the actual rejection is a rejection of Claims 1-19 under 35 U.S.C. 103 as being unpatentable over Stefanopoulos et al., and in view of Schmandt et al., **and further in view of the knowledge available to one having ordinary skill in the art at the time of the invention?** What is the actual rejection? In the event the Board does not reverse its Decision, what is the proper 35 U.S.C. 103 rejection for Appellants to appeal to the Federal Circuit?

Appellants respectfully submit that the Examiner committed error in not changing the stated rejection and the Board committed error in affirming an incorrect rejection. Appellants respectfully request the Board to reverse the rejection of Claims 1-19 under 35 U.S.C. 103 as being unpatentable over Stefanopoulos et al., and in view of Schmandt et al., because it is not the actual rejection of record.

For the record, and to avoid any confusion as to what the prior art is, Appellants respectfully point out that the prior art is Stefanopoulos individually and Schmandt individually. The prior art is NOT a combination of Stefanopoulos and Schmandt. Whether or not they may be combined is a burden placed upon the examiner.


In Graham v. John Deere Co., 148 USPQ 459 (U.S. Sup. Ct. 1966), the U.S. Supreme Court clearly and explicitly compared Scoggin's invention first to the Lohse patent individually, thereafter to the Mellon patent individually, and thereafter to the Livingstone patent individually. 148 USPQ 459, 472. Such an individual assessment of the prior art references is considered well-settled law in view of the fact that the obviousness statute, 35 USC 103, "refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102". Graham, 148 USPQ 459, 465-466 (quoting the Senate and House Reports, S. Rep. No. 1979, 82<sup>nd</sup> Cong., 2d Sess. (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. (1952)). Thus, Graham requires that each reference be assessed individually to ascertain how it differs from the claims. This should be clear by realizing that 35 USC 103 has as its predicate 35 USC 102. If the factual inquiry of ascertaining the differences between the prior art and the claims results in a finding that there are no differences between the prior art (e.g., any single reference) and the claims, then a rejection under 35 U.S.C. 102 would be proper without any necessity of a rejection under 35 USC 103. Thus, when ascertaining differences between the prior art and the claims, each reference is to be taken individually as under 35 USC 102.

In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983), states well the test for determining whether the ascertained differences between the prior art and the claims are such that the claimed subject matter as a whole would have been obvious: "whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention". Thus, the teachings of the prior art are to be evaluated as a combined whole, but after the differences between the prior art and the claims have been ascertained. Both In re Keller, 208 USPQ2d 871, 880-881, and In re Merck & Co., 800 F.2c 1091, 231 USPQ 375 (Fed. Cir. 1986), relied on by the Examiner, assess the combined teachings of the prior art only after the differences between the prior art and claims had been determined.

CONCLUSION

In view of the foregoing discussion, Appellants request favorable reconsideration of the Board Decision and a reversal of the 35 U.S.C. § 103 rejection of Claims 1-19.

Respectfully submitted,



Ronald O. Neerings  
Reg. No. 34,227  
Attorney for Appellants

TEXAS INSTRUMENTS INCORPORATED  
P.O. BOX 655474, M/S 3999  
Dallas, Texas 75265  
Phone: 972/917-5299  
Fax: 972/917-4417 or 917-4418